

Attorney Docket No. 3399P072

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application for:

Tom R. Vandermeijden

Serial No.: 09/945,072

Filing Date: August 31, 2001

For: METHOD AND APPARATUS FOR
AUTOMATICALLY POPULATING A
CONTACT DATABASE IN A MOBILE
COMMUNICATION DEVICE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Examiner: Elahee, MD S.

Group Art Unit: 2645

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August 19, 2005

(Date of Deposit)

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8/19/05

(Date)

RESPONSE TO OFFICE ACTION

Sir:

In response to the Office Action dated May 19, 2005, Applicant respectfully requests reconsideration of the present application in view of the following remarks.

Claims 10-15 have been canceled in this amendment. No claims have been amended or added in this amendment.

Claim 10 was rejected for obviousness-type double-patenting based on co-pending U.S. patent application no. 09/945,414. Claims 1-3, 5, 6, 8, 9, 16-18, 20, 21, 23, 25-27, 29, 30, 32 and 33 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent no. 6,687,242 of Enzmann et al. ("Enzmann") in view of U.S. Patent application publication no. 2002/0019225 of Miyashita ("Miyashita"). Claims 4, 19 and 28 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further

in view of Fleming. Claims 7, 22 and 31 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Ho et al. Claims 9, 24 and 33 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Armanto.

The obviousness-type double patenting rejection is moot in view of the cancellation of claims 10-15.

As to the prior art rejections, Applicants respectfully traverse. The present invention relates to a technique by which a mobile communication device can automatically populate a contact database in the mobile communication device. In certain embodiments, the device responds to the occurrence of a voice call (either an incoming call or an outgoing call) by automatically obtaining data associated with a telephone number of the call via a wireless network, and then storing that data in a contact database in the mobile device in association with the telephone number. For example, in response to an outgoing voice call, a mobile phone may automatically obtain, via the network, contact information (e.g., the name and address) of the person/entity being called and then store that contact information in a contact database in the mobile phone. Or, in response to an incoming call, the name and address of the caller can be automatically obtained via the network and stored in the contact database of the mobile phone. As another example, in response to an incoming voice call, a mobile phone may automatically obtain, via the data connection, a ring tone associated with the caller and then store that ring tone in the contact database in the mobile phone. Of course, the claimed invention is not limited to these specific examples.

Referring now to the claims, claim 1 as amended recites:

1. (Previously presented) A method of automatically populating a contact database in a mobile communication device configured to communicate voice and data over a wireless network, the method comprising, **in response to a call event representing a voice call** involving the mobile communication device:

receiving a telephone number associated with the voice call involving the mobile communication device; and

when a data connection is established between the mobile communication device and a remote processing system via the wireless network, **then automatically**

obtaining data associated with the telephone number via the wireless network, and

storing the data in the contact database in association with the telephone number.

(Emphasis added.)

No combination of the cited references discloses or suggests such a method.

The Examiner states, "It is not clear whether Enzmann teaches storing the data in the contact database in association with the telephone number." Office Action, p. 4.

Applicants respectfully submit that Enzmann does not teach or suggest such functionality. (That is not surprising, since Enzmann and the present invention are directed to solving two completely unrelated problems -- see col. 1, lines 23-25 of Enzmann compared to paragraph [0003] of the present application.)

Regardless, the Examiner contends that Miyashita discloses storing the data in the contact database in association with the telephone number, and that it would be obvious to combine such teaching in Miyashita with the teachings of Enzmann. Applicant respectfully disagrees that Miyashita discloses this. Furthermore, the Examiner appears to have not read all of the limitations of Applicant's claim 1 together.

Miyashita discloses a technique by which a party who receives a telephone call at a mobile phone can access additional information about the calling party, such as a

web page. Miyashita further discloses that in response to receiving a telephone call, the mobile phone contacts a directory server and downloads directory data from the directory server. The directory data contains “at least one of a name, phone number and electronic mail address . . .” Miyashita, page 2, para. [0021].

Assuming *arguendo* the downloaded records in Miyashita constitute a “contact database”, Applicant’s claim 1 further requires that the data associated with the telephone number is obtained and stored in the contact database *automatically* in response to a call event representing a voice call involving the mobile communication device (see bold text in claim 1 quoted above). In contrast, Miyashita discloses that the directory data is downloaded “*in response to an operation by a user of the mobile device*,” i.e., not automatically (emphasis added).

Neither Enzmann nor Miyashita discloses or suggests a method in which data associated with the telephone number is obtained and stored in the contact database in a mobile communication device *automatically* in response to a call event representing a voice call involving the mobile communication device, particularly in combination with the other recited steps of claim 1. As such, claim 1 and all claims which depend on it are patentable over the cited art.

Furthermore, there is no suggestion or motivation in the prior art to combine the teachings of Miyashita with those of Enzmann. The motivation alleged by the Examiner is: “. . . in order to retrieve contact information from the storage whenever a person needs to contact without any inconvenience.” Office Action, p. 5. Applicant finds no support in the prior art for that bare bones statement of motivation. The Examiner clearly is relying upon hindsight that is improperly based only on Applicant’s disclosure.

The suggestion or motivation to combine references may not be found using hindsight gleaned from the applicant's specification. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). While hindsight may be unavoidable to some extent in evaluating obviousness, it is never permissible *when it is gained from an applicant's disclosure. Id.*

For this additional reason, therefore, claim 1 is patentable over the cited art.

Independent claims 16 and 25 contain limitations similar to those discussed above and are, therefore, also patentable over the cited art for similar reasons.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.


Conclusion

For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,
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